The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte MARC TREMBLAY and WILLIAM JOY

Appeal No. 2005-0499
Application No. 09/812,733

ON BRIEF

Before JERRY SMITH, LEVY, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 34, 37, and 38.

We affirm.

## BACKGROUND

The invention relates to a processor including a large register file that utilizes a dirty bit storage coupled to the register file and a dirty bit logic that controls resetting of the dirty bit storage. The dirty bit logic determines whether a register or a group of registers in the register file has been written since the process was loaded or the context was last restored. Representative claim 34 is reproduced below.

34. A context switch controller in a processor comprising:

a data storage unit divided into a plurality of storage groups;

a dirty bit storage coupled to the data storage and including one or more storage bits corresponding to one or more respective storage groups in the data storage unit; and

a dirty bit logic coupled to the dirty bit storage and configured to receive a destination address of one or more instructions executing on the processor.

The examiner relies on the following reference:

| | | |
|---|---|---|
| Emer et al. (Emer) | US 6,470,443 B1 (effective filing date Dec. 31, 1996) | Oct. 22, 2002 |

We refer to the Final Rejection (Paper No. 9) and the Examiner's Answer (Paper No. 20) for a statement of the examiner's position and to the Brief (Paper No. 18) and the Reply Brief (Paper No. 21)[1] for appellants' position.

Claims 1-28 have been canceled.

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[1] Although the examiner indicated that the Reply Brief was not entered (see Paper No. 22), the examiner did not have authority to refuse entry of a timely filed reply brief. See 37 CFR § 1.193(b)(1) (2004) ("The primary examiner must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief."). However, the error was harmless, because there were no substantive arguments in the Reply Brief requiring response.

Claims 29-38 were rejected in the Final Rejection, claims 29-32 and 34-38 under 35 U.S.C. § 101 (double patenting) and claim 33 for obviousness-type double patenting. The rejection of claims 29, 34, 35, 37, and 38 under 35 U.S.C. § 101 has been withdrawn (Answer at 4).[2] We infer that the rejection of claim 33 has also been withdrawn, because claims 29, 33, and 35 are indicated as being allowed (id.). We infer, further, that the examiner considers claim 35 to represent allowable subject matter, but is not now allowed, as it depends from rejected claim 34.

The status of claims 30-32 and 36 is unclear. The examiner states (Answer at 5) that the claims are "withdrawn from consideration," and no rejection of the claims is referenced or set forth in the Answer. In any event, in view of the Brief (with Appendix of Claims), appellants are not maintaining the appeal with respect to the final rejection of claims 30-32 and 36.

The sole rejection that is the subject of this appeal is thus that applied against claims 34, 37, and 38, under 35 U.S.C. § 103 as being unpatentable over Emer.

## OPINION

At the outset, we emphasize that the claims on appeal are claims 34, 37, and 38 as they stand, which is as they stood at the time of the final rejection (i.e., the

[2] The Answer states that the rejection is withdrawn "in view of the Terminal Disclaimer." As noted, correctly, in the Final Rejection, a terminal disclaimer cannot overcome a double patenting rejection under 35 U.S.C. § 101. We consider the withdrawal of the rejection as indication that the examiner found appellants' position in the Brief to be persuasive.

amendment filed October 22, 2002 (Paper No. 7)). Appellants have filed three proposed amendments after the final rejection, none of which were approved for entry by the examiner. Appellants proffered the third proposed amendment with the Reply Brief, asserting that entry would dispose of all issues on appeal, and asking that the Board direct the examiner to enter the amendment.

However, the Board exercises no general supervisory power over the examining corps. Decisions within the primary examiner's discretion, such as whether or not to enter an amendment after final rejection, are not subject to our review. See In re Berger, 279 F.3d 975, 984-85, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (issue of examiner's refusal to enter amendment after final may be the subject of a petition, but may not be reviewed by the Board in connection with a rejection of claims); 37 CFR § 1.127 ("From the refusal of the primary examiner to admit an amendment, in whole or in part, a petition will lie to the Director under § 1.181.").

We select claim 34 as representative in our review of the examiner's rejection, consistent with the rules in effect at the time of filing the Brief. See 37 CFR § 1.192(c)(7) (2003).

The examiner relies on the same evidence in rejecting claim 34 in the Final Rejection and in the Answer (i.e., the Emer reference). However, the examiner shifts position in the Answer. The examiner finds that Emer teaches a data storage unit, dirty

bit storage, and dirty bit logic (col. 4, l. 60 - col. 5, l. 20; Fig. 2),[3] but admits that the components are not disclosed as being part of a context switch controller (although context switching is discussed at col. 1, ll. 31-39 of the reference). However, the examiner finds that Emer meets all the structural limitations in the body of claim 34, and provides reasons why the preamble of claim 34 (i.e., the "context switch controller") is considered to not limit the scope of the encompassed subject matter.

Although ostensibly based on § 103, the rejection of claim 34 as set forth in the Answer could thus be regarded as a finding of anticipation. In any event, a finding of anticipation means that the claim is also obvious under 35 U.S.C. § 103; anticipation is the epitome of obviousness. See, e.g., Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983); In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).

We consider the examiner's position with respect to the preamble of claim 34 to be reasonable. The preamble of a claim does not limit the scope of the claim when it merely states a purpose or intended use of the invention. In re Paulsen, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Appellants did not complain (e.g., by way of petition) that the reasoning in the Answer represented a new ground of rejection. Appellants could have responded to

[3] We add that claim 34 does not require a plurality of storage groups.

the examiner's new rationale in the Reply Brief, but did not, other than with the inferences that may be drawn from the act of submitting an amendment to cancel instant claim 34.[4]

The examiner bears the initial burden of presenting a prima facie case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant. After evidence or argument is submitted by the applicant in response, patentability is determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Since appellants have not persuaded us of error in the examiner's findings in support of the rejection of at least representative claim 34, we sustain the rejection on appeal.

## CONCLUSION

The rejection of claims 34, 37, and 38 under 35 U.S.C. § 103 is affirmed.

[4] The examiner had authority to refuse entry of the amendment filed with the Reply Brief but, as we have previously noted, not the Reply Brief.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a). See 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

JERRY SMITH
Administrative Patent Judge

STUART S. LEVY
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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